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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,565	11/29/2001	Satoshi Hirano	216369US2DIV	3208

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EXAMINER

MCKINNON, TERRELL L

ART UNIT PAPER NUMBER

3743

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,565

Applicant(s)

HIRANO, SATOSHI

Examiner

Terrell L Mckinnon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/29/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/505,687.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's election with traverse of species related to figure 1 and claim 4 readable thereon in Paper No. 5 is acknowledged.

The applicant's first traversal is on the grounds that the election requirement merely provides a conclusory statement and does not present particular reasons for such a holding. Hence, the PTO has not carried its burden of proof stated in MPEP 816.

This is not found persuasive because the Examiner required a species election not a restriction of invention. Therefore, the examiner does not have to give reasons why the species are different.

The second traversal is on the grounds that applicant respectfully submits that there is no undue burden on the Examiner to search all the claims under MPEP 803. Searching a plurality of species is a burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3 and 6-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, the requirement having been traversed in Paper No. 5.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Perry et al.

(U.S. 4,142,576).

Perry discloses a heat storage system comprising:

- a heat storage tank (fig. 3, (29)) charged with a heat storage material for storing the heat supplied from the outside (column 1, lines 59-63, column 2, lines 45-52);
- heat exchange means (14, 14a, and 14b) for executing an injection and extraction of heat between the inside of the storage tank and the outside by the heat exchange between the heat storage material and a heat transfer medium (column 3, lines 50-53, and lines 65-68);
- the heat exchange means is disposed to sequentially execute heat exchange between the central portion in the storage tank and the outside;
- a suppression means (20) being disposed on the outer portion of the storage tank for suppressing natural convection of the heat storage material (column 2, lines 65-68); wherein
- the suppressing means is constituted by dispersing a liquid-absorbent material in the heat storage material (column 4, lines 37-43, and column 5, lines 24-30).

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are cited for disclosing related limitations of the applicant's claimed and disclosed invention. Charles Dewey Havill, Hitchin, Goswami et al., Helmbold, Ashe, and Faghri.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terrell L Mckinnon whose telephone number is 703-305-0059. The examiner can normally be reached on Monday -Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 305-4456. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7764 for regular communications and 703-308-7764 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Terrell L Mckinnon
Examiner
Art Unit 3743
October 18, 2002